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BAKER BOTTS L.L.P. 30 ROCKEFELLER PLAZA 44TH FLOOR NEW YORK, NY 10112-4498			EXAMINER SOROUSH, ALI	
			ART UNIT 1617	PAPER NUMBER
			NOTIFICATION DATE 03/15/2012	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DL.NYDOCKET@BAKERBOTTS.COM

**Office Action Summary****Application No.**

10/785,207

**Applicant(s)**

MODAK ET AL.

**Examiner**

ALI SOROUSH

**Art Unit**

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 5) ☒ Claim(s) 1-5,7-10,12,16,19,20,22,33 and 35 is/are pending in the application.
- 5a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 1-5,7-10,12,16,19,20,22,33 and 35 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-SB05)  
Paper No(s)/Mail Date 08062010
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/06/2010 has been entered.

### ***Claim Status***

Claims 1-5, 7-10, 12, 16, 19, 20, 22, 33 and 35 are pending.

Claims 6, 11, 13-15, 17, 18, 21, 23-32, and 34 were previously cancelled.

Claims 1-5, 7-10, 12, 16, 19, 20, 22, 33 and 35 have been examined.

Claims 1-5, 7-10, 12, 16, 19, 20, 22, 33 and 35 are rejected.

### ***Priority***

Priority to CIP PCT/US02/33865 filed on 10/23/2002 which claims priority to CIP 10/047,631 (US Patent 6,846,846) filed on 10/23/2001.

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 08/06/2010 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

This is a new ground of rejection.

Claims 1-5, 7-10, 12, 16, 19, 20, and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 22 recite that the concentration of alcohol present in the composition is between 30% and 95%, water is between 15% to 70%, hydrogel is present between 0.05 to 0.5%, emollient is between 0.2 to 3.0%, between octoxyglycerin is between 1.0 to 5%, and a concentration of quaternary ammonium compound. If the minimum amounts of all the other components are used in formulating the composition the maximum amount of alcohol that can be present is less than 83.75, the maximum of water that can be present is less than 68.75. It is not clear how the composition can comprise as much as 95% alcohol and as much as 70% water in any of the instantly claimed formulations. Furthermore, since the amount of quaternary ammonium compound is not claimed, it is not clear if the compound is optional as the other components can be present in amounts adding up to 100% without the addition of the quaternary ammonium.

Claims 2-5, 7-10, 12, 16, 19, and 20 are indefinite since they depend and incorporate the limitations of indefinite claim 1.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

***Response to Applicant's Arguments***

The rejection of claims 1, 16, 19, and 22 under 35 U.S.C. 103(a) as being unpatentable over Broh-Kahn et al. (US Patent 3257276, Published 06/21/1966) in view of Burnier et al. (US Patent 5736574, Published 04/07/1998) as evidenced by Page (US Patent 4870108, Published 09/26/1989) is withdrawn in view of Applicant's arguments.

The rejection of claims Claim 7 under 35 U.S.C. 103(a) as being unpatentable over Broh-Kahn et al. (US Patent 3257276, Published 06/21/1966) in view of Burnier et al. (US Patent 5736574, Published 04/07/1998) further in view of Noda et al. (US Patent 4393076, Published 07/12/1983) as evidenced by Page (US Patent 4870108, Published 09/26/1989) is withdrawn in view of Applicant's arguments.

The rejection of claims 2-5, 8, 9, 10, and 33 under 35 U.S.C. 103(a) as being unpatentable over Broh-Kahn et al. (US Patent 3257276, Published 06/21/1966) in view of Burnier et al. (US Patent 5736574, Published 04/07/1998) further in view of Modak et al. (US Patent 596510, Published 04/07/1998) as evidenced by Page (US Patent 4870108, Published 09/26/1989) is withdrawn in view of Applicant's arguments.

The rejection of claims 35 under 35 U.S.C. 103(a) as being unpatentable over Broh-Kahn et al. (US Patent 3257276, Published 06/21/1966) in view of Burnier et al. (US Patent 5736574, Published 04/07/1998) further in view of fei et al. (US Patent 6485716 B1, Published 11/26/2002, Filed 10/05/2001) as evidenced by Page (US Patent 4870108, Published 09/26/1989) is withdrawn in view of Applicant's arguments.

This is a new ground of rejection.

Claims 1, 16, 19, 20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKenzie et al. (US Patent 5747021, Published 05/05/1998) in view of Diehl et al. (US Patent 5591442, Published 01/07/1997).

The claims are directed to a composition comprising 30 to 95% alcohol, 15 to 70% water, 0.05 to 0.5% hydrogel, 0.2 to 3.0% emollient, 1.0 to 5.0 octoxyglycerin, and a quaternary ammonium compound, wherein the exhibit synergistic antimicrobial activity, and the composition has a viscosity below 2000 centipoises. The claims are further directed to the ammonium compound being benzalkonium chloride. The claims are further directed to the alcohol being an aliphatic alcohol. The claims are further directed to the aliphatic alcohol being ethanol.

Mckenzie teach an aftershave composition (title) comprising 30-70% isopropyl alcohol, 10-30% ethanol, 0.25-1.75% carbomer (hydrogel), 2-15% glycerin (emollient), and remaining balance of the composition is deionized water (column 3, lines 41-55). The composition has a viscosity of 250 to 500 cps (column 3, lines 56-63).

McKenzie et al. lacks a teaching wherein the composition comprises a synergistic combination of octoxyglycerin and an ammonium compound.

Diehl et al. teach a composition comprising 45% ethanol (which reads on instant claims 19 and 20), 0.6% benzalkonium chloride (which reads on instant claim 16), 0.5% glycerol 1-decyl ether, and water for disinfecting skin (title column 3, lines 25-30). Glycerol 1-(2-ethylhexyl) ether (octoxyglycerin) is the preferred functional alternative to glyceryl 1-decyl ether (column 2, lines 34-40). The amount of ethanol in the composition can be from 15 to 85% and the amount of octoxyglycerin in the composition can be from 0.1 to 5% (column 2, lines 52-54). The combination of antimicrobial agents in the instant invention results in genuine synergism (column 2, lines 12-15). The composition can also include other customary additives and auxiliaries such as surfactants (column 2, lines 57-60).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the instant invention to combine the teachings of McKenzie et al. with Diehl et al. and have a reasonable expectation of success. It would have been obvious in order to provide the after shave composition of McKenzie et al. with antiseptic properties. The instantly claimed component concentrations would have been prima facie obvious on to one of ordinary skill in the art, through routine optimization of the formulation since the instantly claimed concentrations overlap with the amounts taught by the prior art. For the foregoing reasons the instant claims are rendered obvious by the teachings of the prior art.



This is a new ground of rejection.

Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKenzie et al. (US Patent 5747021, Published 05/05/1998) in view of Diehl et al. (US Patent 5591442, Published 01/07/1997) as applied to claims 1, 16, 19, 20, and 22 above, and further in view of Turner et al. (US Patent 5703372, Published 12/17/1991).

The claims are further directed to the composition comprising 0.1 to 1.0% silicone polymer such as dimethiconol fluid in dimethicone.

The teachings of McKenzie et al. and Diehl et al. are discussed above.

McKenzie et al. and Diehl et al. lack a teaching wherein the composition comprises a silicone polymer.

Turner et al. teach a composition for application to the face (title) which can comprise dimethiconol fluid in dimethicone at a preferable concentration of 0.1 to 1% for aid in redistributing sebum across the surface of the skin (column 6, lines 33-56).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the instant invention to combine the teachings of McKenzie et al., Diehl et al., and Turner et al. and have a reasonable expectation of success. One would have been motivated to do so since all the compositions are for application to the skin and in particular the face, and the addition of dimethiconol fluid in dimethicone would provide the after shave composition of McKenzie et al. with a sebum control agent. For the foregoing reasons the instant claims are rendered obvious by the teachings of the prior art.

This is a new ground of rejection.

Claims 8 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKenzie et al. (US Patent 5747021, Published 05/05/1998) in view of Diehl et al. (US Patent 5591442, Published 01/07/1997) as applied to claims 1, 16, 19, 20, and 22 above, and further in view of Wang et al. (US Patent 5110809, Published 05/05/1992).

The claims are further directed to the emollient being PPG-20 methyl glucose ether or PPG-3-myristyl ether.

The teachings of McKenzie et al. and Diehl et al. are discussed above.

McKenzie et al. and Diehl et al. lack a teaching wherein the emollient is PPG-20 methyl glucose ether.

Wang et al. teach a skin gel composition (column 1, lines 23-32) which comprises an emollient such as glycerin, PPG-3-myristyl ether or more preferably PP-20 methyl glucose ether (column 8, lines 24-45).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the instant invention to substitute PPG-20 methyl glucose ether or PPG-3-myristyl ether for glycerin in the composition of McKenzie et al. and have a reasonable expectation of success. One would have been motivated to do so since Wang et al. teach that they are functional alternatives and that PPG-20 methyl glucose ether is more preferable in gel compositions applied to the skin. For the foregoing reasons the instant claims are rendered obvious by the teachings of the prior art.

This is a new ground of rejection.

Claims 2, 9, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKenzie et al. (US Patent 5747021, Published 05/05/1998) in view of Diehl et al. (US Patent 5591442, Published 01/07/1997) as applied to claims 1, 16, 19, 20, and 22 above, and further in view of Wieselmann et al. (US Patent 5869071, Published 02/09/1999) and Ono et al. (US Patent 5827529, Published 10/27/1998).

The claims are further directed to the composition comprising 0.05 to 0.5 behentrimonium methosulfate, cetyl alcohol, and butylene glycol.

The teachings of McKenzie et al. and Diehl et al. are discussed above.

McKenzie et al. and Diehl et al. lack a teaching wherein the composition further comprises behentrimonium methosulfate, cetyl alcohol, and butylene glycol.

Wiesleman et al. teach a skin composition comprising a quaternary ammonium compound and emulsifiers such as behentrimonium methosulfate and cetyl alcohol (title and column 4, lines 20-45).

Ono et al. teach a skin composition wherein propylene glycol and butylene glycol are water-retaining compounds (prior art claim 1).

It would have been prima facie obvious to add behentrimonium methosulfate and cetyl alcohol to the combined composition of McKenzie et al. and Diehl et al. and have a reasonable expectation of success. One would have been motivated to do so since Diehl et al. also comprises a quaternary ammonium compound and the addition of the emulsifiers would emulsify the compound into the topical formulation. It would have been prima facie obvious to substitute propylene glycol for butylene glycol in the

composition of McKenzie et al. and have a reasonable expectation of success. One would have been motivated to do so since Ono et al. teach they are functional alternatives. The instantly claimed component concentrations would have been prima facie obvious on to one of ordinary skill in the art, through routine optimization of the formulation since the instantly claimed concentrations overlap with the amounts taught by the prior art. For the foregoing reasons the instant claims are rendered obvious by the teachings of the prior art.

This is a new ground of rejection.

Claims 1, 4, 5, 7, 12, 19, 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marschner (US Patent 4664909, Published 05/12/1987) in view of Diehl et al. (US Patent 5591442, Published 01/07/1997).

The claims are directed to a composition comprising 30 to 95% alcohol, 15 to 70% water, 0.05 to 0.5% hydrogel, 0.2 to 3.0% emollient, 1.0 to 5.0 octoxyglycerin, and a quaternary ammonium compound, wherein the exhibit synergistic antimicrobial activity, and the composition has a viscosity below 2000 centipoises. The claims are further directed to the ammonium compound being benzalkonium chloride. The claims are further directed to the alcohol being an aliphatic alcohol. The claims are further directed to the aliphatic alcohol being ethanol. The claims are further directed to hydrogel being hydroxyethyl cellulose. The claims are further directed to the composition further comprising 0.5 to 5.0% of an emulsifier solvent. The claims are further directed to the composition further comprising 0.1 to 1.0 thickening agent.

Marschner teaches a composition comprising 17% water, 10% propylene glycol, 0.4% hydroxyethyl cellulose, 64.3% ethanol, 0.5% cab-o-sil (thickening agent), 5% zinc undecylenate, 1% wheat germ glycerides (emollient), 1.5% arlamol E (emollient solvent), and 0.3% perfume for application to the skin (column 6, lines 40-65).

Marshner lacks a teaching wherein the composition comprises a synergistic combination of octoxyglycerin and an ammonium compound.

Diehl et al. teach a composition comprising 45% ethanol (which reads on instant claims 19 and 20), 0.6% benzalkonium chloride (which reads on instant claim 16), 0.5% glycerol 1-decyl ether, and water for disinfecting skin (title column 3, lines 25-30). Glycerol 1-(2-ethylhexyl) ether (octoxyglycerin) is the preferred functional alternative to glyceryl 1-decyl ether (column 2, lines 34-40). The amount of ethanol in the composition can be from 15 to 85% and the amount of octoxyglycerin in the composition can be from 0.1 to 5% (column 2, lines 52-54). The combination of antimicrobial agents in the instant invention results in genuine synergism (column 2, lines 12-15). The composition can also include other customary additives and auxiliaries such as surfactants (column 2, lines 57-60).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the instant invention to combine the teachings of Marschner with Diehl et al. and have a reasonable expectation of success. It would have been obvious in order to provide the after shave composition of Marschner with antiseptic properties. The instantly claimed component concentrations would have been prima facie obvious on to one of ordinary skill in the art, through routine optimization of the formulation since the

instantly claimed concentrations overlap with the amounts taught by the prior art. For the foregoing reasons the instant claims are rendered obvious by the teachings of the prior art.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 3, 5-10, 12, 13, 16, 19, 20, and 22 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1, 3-11, and 17 of copending Application No. 10/622272. Although the conflicting claims are not identical, they are not patentably distinct from each other because application 10/622272 teaches a composition that comprises organic salts of zinc, 10 to 80 % water, ethanol one or more of agent selected from the group consisting of a 0.05 to 10.0% gelling agent, a thickening agent, an emulsifying agent and an 0.3 to 10.0%

emollient. The composition can further comprise 0.1 to 1.0% silicone polymer and 0.05 to 4% antimicrobial agent. It would have been obvious to one of ordinary skill in the art to combine all of the optional compounds at the instantly claimed concentrations.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Response to Applicant's Arguments***

Applicant argues that since the overlapping claims have not yet been patented Applicants will agree to submit a terminal disclaimer at such necessary time. Therefore, the instant rejection of claims 1, 2, 3, 5, 7-10, 12, 13, 16, 19, 20, and 22 on the ground of nonstatutory obviousness-type double patenting is maintained.

### ***Conclusion***

No claims allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALI SOROUGH whose telephone number is (571)272-9925. The examiner can normally be reached on M-F (9am-6pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fereydoun G. Sajjadi can be reached on (571)272-3311. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ALI SOROUGH/  
Examiner, Art Unit 1617

March 11, 2012